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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/790,674   | 03/03/2004  | Gina Parmar          | 016778-0474         | 2300             |
| 22428  | 7590        | 04/21/2006           | EXAMINER            |                  |
| FOLEY AND LARDNER LLP<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      | LE, DANH C          |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             |                      | 2617                |                  |

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/790,674             | PARMAR ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | DANH C. LE             | 2617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 3/3/04 has been considered by the examiner and made of record in the application file.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, respectively of U.S. Patent No. 6,725,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 of the U.S. Patent No. 6,725,039 encompass claims 1-12 of the present application.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 6, 9-12 are the hardware apparatus radio network controller which are dependent on the method claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims are rejected under 35 U.S.C. 102(e) as being anticipated by Lintulampi (US 6,377,804).**

As to claim 1, Lintulampi teaches a method of establishing Universal Mobile Telecommunications System (UMTS) communication between User Equipment (UE) and a UMTS network, wherein the User Equipment is in communication with a Global System for Mobile communication (GSM)-type network (figure 4A-B and 5A-B), the method comprising:

forwarding UMTS Terrestrial Radio Access Network (UTRAN) parameter information to the User Equipment via the GSM-type network; and in the User Equipment, interpreting the UTRAN parameter information and initiating communication with the UMTS network.

As to claim 2, Lintulampi teaches a method according to claim 1, wherein the UTRAN parameter information is supplied by a Radio Network Controller of the UMTS network (figure 4A-B and 5A-B).

As to claim 3, Lintulampi teaches a method according to claim 1, wherein the UTRAN parameter information comprises a list of potential UTRAN access points (figure 4A-B and 5A-B).

As to claim 4, Lintulampi teaches a method according to claim 1, wherein the UE is arranged to establish a link through the Radio Network Controller (RNC) of the UMTS network to the MSC of the GSM-type network.

As to claim 6, the claim is a system claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 7, Lintulampi teaches a message or data packet in a GSM network containing UTRAN parameters for handing over a GSM call to a UMTS network addressed to User Equipment engaged in a GSM call and capable of switching to a UMTS call (figure 4A-B and 5A-B).

As to claim 9, the limitation of the claim is the same limitation of claim of claim 2; therefore, the claim is interpreted and rejected as set forth as claim 2.

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As to claim 10, the limitation of the claim is the same limitation of claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 11, the limitation of the claim is the same limitation of claim of claim 4; therefore, the claim is interpreted and rejected as set forth as claim 4.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi in view of Le (US 6,556,820).**

As to claim 5, Lintulampi teaches a method according to claim 1, Lintulampi fails to teach the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le teaches the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links (col.13. lines 2-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Le into the system of Lintulampi in order to update on adynamic basis.

As to claim 12, the limitation of the claim is the same limitation of claim of claim 5; therefore, the claim is interpreted and rejected as set forth as claim 5.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Korpela (US 6,311,054) teaches method for determine charging information in a mobile telecommunication system and a mobile station.
- B. Roberts et al (US 6,792,283) teaches method of selecting cells in a cellular mobile radio system.
- C. Gourgue et al (US 6,584,116) teaches method of transmission in a UMTS mobile telephone network enabling preparation for handover to a GSM cell during a call in a UTMS cell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

danh

April 14, 2006.

DANH CONG LE  
PRIMARY EXAMINER